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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,849	03/26/2001	David Trane	T005.PAT-2	2691
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Emery L. Tracy P.O. Box 1518 Boulder, CO 80306-1518		EXAMINER SHANNON, MICHAEL R		
		ART UNIT PAPER NUMBER		
		2614		

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/817,849	Applicant(s) TRANE, DAVID	
	Examiner Michael R Shannon	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20010524, 20010806</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton et al US patent 6,233,389, cited by applicant, in view of Kenner et al US patent 5,956,716, cited by examiner.

Regarding claim 1, the claimed video recording system for recording and playing video programming is met as follows:

The Barton reference teaches the following:

- The housing is met by the inherent housing of the system as discussed in column 1, lines 63-67.
- The at least one memory storage device for storing video programming, each memory storage device being mounted within the housing is met by the memory 104 and Hard Disk 105 [Fig. 1], which are both built into the inherent housing.

The Barton reference does not disclose an Internet connection for connecting the memory storage device to the Internet, nor does it disclose downloading means for downloading video programming through the Internet connection

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and storing the downloaded video programming on the memory storage device.

The Kenner reference discloses the following:

- The Internet connection for connecting the memory storage device to the Internet is met by the Internet connections from Internet 56 to Routers 86 [Abstract].
- The downloading means for downloading video programming through the Internet connection and storing the downloaded video programming on the memory storage device is met by the discussion of downloading and storing video clips over the internet to a local memory device [Abstract, & col. 15, line 58 – col. 16, line 61].

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize an Internet connection to download video programming, in order to receive video programming over a standard computer network such as the Internet and to allow for greater flexibility and greater access to the vast amount of video programming available on the Internet.

Regarding claim 2, the claimed recording means for recording broadcast programming onto the memory storage device, the broadcast programming selected from the group consisting of television broadcasts, cable television input, and satellite input is met by the Barton reference, wherein it discloses that programming can be input via multiple forms and stored in the storage device [col. 2, lines 4-33].

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Regarding claim 3, the Barton and Kenner references disclose all of that which is discussed above with regards to claim 1. The Barton reference does not disclose a button mounted to the housing for activating the Internet connection and connecting to any predetermined Internet site. Kenner et al teach that a user can request video clips via a "user request", which serves to connect to an Internet site and download requested video clips [Abstract]. It would have been obvious to one of ordinary skill in the art at the time of the invention to place a button on the housing that allowed the user to request video clips from a specific website, in order to make the system intuitive and allow the user quick and easy access to media content from a specific site.

Regarding claim 4, the claimed downloading means comprising software and firmware for converting analog signals to digital format and encoding and decoding means for authorizing downloading from predetermined internet sites is met by the MPEG encoder 703 [Fig. 7], which serves to encode analog signals to digital signals for storage within the device and, in conjunction with the MPEG Decoder 715, allow only authorized play of the media content.

Regarding claim 5, the claimed read/write removable media drive that is selected from the group consisting of a read/write CD drive, a read/write mini-disc drive, a floppy disc drive, and a read/write DVD drive, and further wherein the read/write removable media is selected from the group consisting of a read/write CD, a read/write mini-disc, a floppy disc, and a read/write DVD is met by the discussion of the DVD-RAM drive, which can be used as the multimedia recording device [col. 12, lines 15-20].

Regarding claim 6, the claimed means for recording from the memory storage device to the read/write removable media is met by the discussion of the backup system [col. 11, lines 40-41], which can backup the locally stored video content onto a VCR or, as is mentioned above, a DVD-RAM drive.

Regarding claim 7, the claimed temporary storage means within the housing for allowing recording of at least one input or channel while playing another input or channel is met by the discussion of allowing a viewer to store and watch two different program simultaneously [col. 2, lines 1-5].

Regarding claim 8, the claimed external remote control device for controlling the operations of the video recording system is met by the control device 917 and the remote control discussed on column 9, lines 22-36, which are both used for controlling operations of the system.

Regarding claim 9, the Barton and Kenner references teach all of that which is discussed above with regards to claim 1. Barton et al do not teach a data jack that connects the memory storage device and read/write removable drive to the Internet. Kenner et al teach a system that connects a storage device to the Internet, in order to download video clips. It is inherent in the disclosed connection, that there is a data jack that connects the device to the Internet [Abstract]. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a data jack for connection to the Internet, in order to allow for a standard way and a common port for connecting to a network as large as the Internet.

Regarding claim 10, the method is rejected based on the same grounds as the rejection for claim 1.

Regarding claim 11, the claimed device for recording video programming is met as follows:

The Barton reference teaches the following:

- The read/write removable media drive is met by the discussion of the DVD-RAM drive, which can be used as the multimedia recording device [col. 12, lines 15-20].
- The read/write removable media receivable within the read/write removable media drive is met by the same discussion, wherein the DVD-RAM media is inserted into the DVD-RAM drive [col. 12, lines 15-20].

The Barton reference does not disclose an Internet connection for connecting the read/write removable media drive to the Internet, nor does it disclose downloading means for downloading video programming from the Internet and storing the downloaded video programming on the read/write removable media.

The Kenner reference discloses the following:

- The Internet connection for connecting the read/write removable media drive to the Internet is met by the Internet connections from Internet 56 to Routers 86 [Abstract].

- The downloading means for downloading video programming from the Internet and storing the downloaded video programming on the read/write removable media is met by the discussion of downloading and storing video clips over the internet to a local memory device [Abstract, & col. 15, line 58 – col. 16, line 61].

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize an Internet connection to download video programming, in order to receive video programming over a standard computer network such as the Internet and to allow for greater flexibility and greater access to the vast amount of video programming available on the Internet.

Regarding claim 12, the claimed means for recording broadcast programming of television broadcasts, cable television input, and satellite input onto the read/write removable media drive is met by the Barton reference, wherein it discloses that programming can be input via multiple forms and stored in the storage device [col. 2, lines 4-33], such as the aforementioned DVD-RAM drive.

Regarding claim 13, the claimed read/write removable media drive that is selected from the group consisting of a read/write CD drive, a read/write mini-disc drive, a floppy disc drive, and a read/write DVD drive, and further wherein the read/write removable media is selected from the group consisting of a read/write CD, a read/write mini-disc, a floppy disc, and a read/write DVD is met by the discussion of the DVD-RAM drive, which can be used as the multimedia recording device [col. 12, lines 15-20].

Regarding claim 14, the claimed at least one memory storage device for storing video programming downloadable through the Internet is met by the memory 104 and Hard Disk 105 [Fig. 1], which are both built into the system. Barton does not teach that the memory storage devices are linked to the Internet for downloading of video programming. Kenner et al teach an Internet connection, which downloads and stores video clips over the Internet to a local memory device [Abstract, & col. 15, line 58 – col. 16, line 61]. It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize an Internet connection to download video programming, in order to receive video programming over a standard computer network such as the Internet and to allow for greater flexibility and greater access to the vast amount of video programming available on the Internet. Secondly, Barton teaches the claimed means for transferring video programming between read/write removable media within the read/write removable media drive and the memory storage device is met by the discussions of the DVD-RAM being used in place of a VCR in order to backup and transfer information from the memory to the DVD-RAM [col. 11, line 40 – col. 12, line 19].

Regarding claim 15, the claimed recording means for recording broadcast programming onto the memory storage device, the broadcast programming selected from the group consisting of television broadcasts, cable television input, and satellite input is met by the Barton reference, wherein it discloses that programming can be input via multiple forms and stored in the storage device [col. 2, lines 4-33].

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Regarding claim 16, the claimed means for recording to the memory storage device first and then transferring the recorded programming to the read/write removable media is met by the discussions of the DVD-RAM being used in place of a VCR in order to backup and transfer information from the memory to the DVD-RAM [col. 11, line 40 – col. 12, line 19].

Regarding claim 17, the claimed means for recording to the read/write removable media first and then transferring the recorded programming to the memory storage device is met by the discussion of recording directly from TV to the VCR (replaceable by the DVD-RAM), then recording to the storage memory disk [col. 11, line 40 – col. 12, line 19].

Regarding claim 18, the Barton and Kenner references teach all of that which is discussed above with regards to claim 1. Barton et al do not teach a data jack that connects the memory storage device and read/write removable drive to the Internet. Kenner et al teach a system that connects a storage device to the Internet, in order to download video clips. It is inherent in the disclosed connection, that there is a data jack that connects the device to the Internet [Abstract]. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a data jack for connection to the Internet, in order to allow for a standard way and a common port for connecting to a network as large as the Internet.

Regarding claim 19, the claimed downloading means comprising software and firmware for converting analog signals to digital format and encoding and decoding means for authorizing downloading from predetermined internet sites and transferring

between the memory storage device and the read/write removable drive is met by the MPEG encoder 703 [Fig. 7], which serves to encode analog signals to digital signals for storage within the device and, in conjunction with the MPEG Decoder 715, allow only authorized play of the media content. Also, the transferring process is discussed in column 11, line 40 – column 12, line 19.

Regarding claim 20, the claimed temporary storage means within the housing for allowing recording of at least one input or channel while playing another input or channel is met by the discussion of allowing a viewer to store and watch two different program simultaneously [col. 2, lines 1-5].

Regarding claim 21, the claimed method is met by the discussion of the uses of the system as described in the rejection to claim 11.

Regarding claim 22, the claimed method for downloading video programming from any external Internet location is met as follows:

The Barton reference discloses the following:

- The claimed step of providing a data storage device is met by the memory 104 and Hard Disk 105 [Fig. 1].
- The claimed step of encoding and decoding information is met by met by the MPEG encoder 703 [Fig. 7], which serves to encode analog signals to digital signals for storage within the device and, in conjunction with the MPEG Decoder 715, allow only authorized play of the media content

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- The claimed step of downloading the video programming is met by the Input Streams to the Input Module.
- The claimed step of storing the video programming on the data storage device is met by the discussion of the reception and storage of video programming [col. 1, line 63 – col. 2, line 32].
- The claimed step of playing the stored video programming on a television is met by the Output Module and the discussion of outputting to a TV [col. 2, lines 26-32].

The Barton reference does not disclose the step of connecting the storage device to the external Internet location.

The Kenner reference discloses an Internet connection that can be used to connect the storage device to the Internet for the purpose of downloading video clips [Abstract].

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize an Internet connection to download video programming, in order to receive video programming over a standard computer network such as the Internet and to allow for greater flexibility and greater access to the vast amount of video programming available on the Internet.

Regarding claim 23, the claimed step of receiving television, cable, satellite, or other broadcasts is met by the Barton reference, wherein it discloses that programming can be input via multiple forms and stored in the storage device [col. 2, lines 4-33]. The claimed step of digitizing the broadcasts is met by the MPEG encoder 703, which

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serves to digitize incoming analog signals. The claimed step of recording the broadcasts on the data storage device is met by the discussion of the reception and storage of video programming [col. 1, line 63 – col. 2, line 32].

Regarding claim 24, the claimed step of transferring the downloaded video programming to a read/write removable media is met by the discussions of the DVD-RAM being used in place of a VCR in order to backup and transfer information from the memory to the DVD-RAM [col. 11, line 40 – col. 12, line 19].

Regarding claim 25, the claimed step of transferring the downloaded video programming to a memory storage device is met by the discussion of the reception and storage of video programming [col. 1, line 63 – col. 2, line 32].

Regarding claim 26, the claimed step of temporarily storing the downloaded video programming prior to storing of the downloaded video programming on the storage device is met by the use of the FIFO 706 and the ability to temporarily store before sending the video programming to the hard disk 710.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Isaka US patent 5,706,388 discloses a system for downloading received programming information and recording it for output at a later time.

Safadi et al US Pub. 2001/0051037 disclose a system for connecting a PVR to the Internet using a 10/100 Base-T connection.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael R Shannon whose telephone number is 703-305-6955. The examiner can normally be reached on M-F 7:30-5:00, alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael R Shannon
Examiner
Art Unit 2614

Michael R Shannon
December 14, 2004


JOHN MILLER
SUPERVISORY PATENT EXAMINER
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